

REMARKS

Claims 1-3, 5, 11-13, 15 and 21 are rejected under 35 U.S.C. §112 as being indefinite. This rejection is overcome in view of the amended and canceled claims.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman (US20040260843) in view of Saunders (Newcard Exposed), and in further view of Harari et al (US6266724) hereinafter Harari. Claims 9-10 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman as applied to claim Saunders above, and further in view of Cheng et al (US6935130) hereinafter Cheng. This rejections are not applicable to the claims as amended.

Claims 1, 11 and 21 include: power means including one of a power adapter connected to provide power to the second subsystem including the user console, whereby the optional power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach power means including one of a power adapter connected to provide power to the second subsystem

including the user console, whereby the optional power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches nor suggests power means including one of a power adapter connected to provide power to the second subsystem including the user console, whereby the optional power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

In view of all of the above, the allowance of claims 1, 4, 6-11, 14 and 16-22 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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